



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLN. OF: OKADA et al.

SERIAL NO.: 09/913,625

FILED: AUGUST 16, 2001

FOR: HYDROGEN STORAGE METAL ALLOY AND METHOD...

GROUP: 1742

EXAMINER: SIKYIN IP

DOCKET: SHIG C11119

Assistant Commissioner of Patents & Trademarks
Washington, D.C. 20231

AMENDMENT A

Dear Sir:

In response to the Restriction Requirement mailed September 26, 2002, Applicants provisionally elect, with traverse, to prosecute the invention of Group II, i.e., claims 9-12 and 19-21.

The Restriction Requirement is respectfully traversed. The Official Action has not established a *prima facie* justification for the Restriction Requirement. In the Action, the Examiner makes reference to the alleged unpatentability of claim 9. A requirement for the restriction has nothing to do with unpatentability of claims for any of the inventions being claimed. It is agreed that a rejection of any claim cannot be based on unpatentability implied to such a claim due to unpatentability of another claim. The sole basis for unpatentability resides in the Statutes. The Statutes do not authorize unpatentability to be implied from other claims of the same application. Nothing in the Statutes permits unpatentability of claims to be based on

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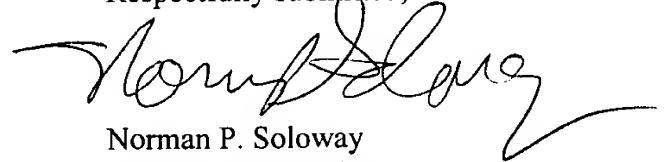
unpatentability being implied from unpatentable other claims. A restriction requirement has nothing to do with patentability or unpatentability.

Furthermore, the Examiner's reference to PCT Rule 13.1/13.2 is believed to be misplaced. Notwithstanding, so as to be fully responsive, Applicants provisionally elect, with traverse, claim Group II, i.e., claims 9-12 and 19-21, and request that the non-elected claims be maintained in this Application for possible rejoinder and/or for filing of a divisional application.

Examination of the Application on its merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

Respectfully submitted,



Norman P. Soloway
Attorney for Applicant
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on October 8, 2002 at Tucson, Arizona.

By: Najat M. Lalami

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